

### **REMARKS**

Reconsideration and allowance in view of the forgoing amendment and the following remarks are respectfully requested.

#### **Rejection of Claims 1, 3, 4, 6 and 18 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 1, 3, 4, 6 and 18 under 35 U.S.C. §103(a) as being unpatentable over Cobbley et al. (U.S. Patent No. 5,818,510) ("Cobbley et al.") in view of Hooks et al. (U.S. Patent No. 6,169,542) ("Hooks et al.") and further in view of Dimitrova (U.S. Patent No. 6,363,380) ("Dimitrova"). Assignee respectfully traverses this rejection and provides further comments on the analysis in the Office Action. Assignee thanks the Examiner for the detailed response to arguments on pages 2-4 of the Office Action which helps to understand the Examiner's position with respect to the interpretation of the art. Assignee shall further explain and identify areas in which the analysis in the Office Action is unpersuasive with respect to the scope of the teachings of the prior art.

Specifically, Assignee shall first address the Cobbley et al. reference and the portions cited on page 2 of the Office Action. Here, the Office Action states that "Cobbley discloses a module... configured to classify a media collection as program content verses television commercials..." Window 210 in column 5, line 5 through column 12, line 12 are cited as including "sports news, local news, commercial, real-time stock, weather report, text associated with video, etc....". In the bolded portion of page 2, the listing of secondary data is again highlighted as "sports news, local news... commercial, national news, weather, etc." (emphasis added) These are transmitted for example "repeating news transmission... five minutes every half-hour..." and within the main program. Assignee respectfully traverses the analysis in which the "commercial" that is listed on page 2 is the equivalent of the recited television commercial. Assignee respectfully submits that the "commercial" mentioned in Figure 2 is not a television

commercial. Assignee notes that it is most tempting to simply equate the word “commercial” found in Figure 2 with the recited television commercial.

However, under a §103 analysis, the MPEP requires the Examiner to avoid impermissible hindsight. For example, MPEP 2142 states “the tendency resort to ‘hindsight’ based on Applicants disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts claimed from the prior art.” In this case, Assignee notes that the word “commercial” is not found in the specification itself, but only found in Figure 2. The listing of items 214 in Figure 2 are explained to be items that fall under the category of displayed story segment titles 214. See column 11, lines 15-17. Note that in window 210, each of the displayed story segment titles 214 are indented under the “subject matter heading” 212. See Id. Column 11, starting at line 14 explains that the “index display 210 provides multiple subject matter headings 212 of the program segments to the individual user from cache index 128.” In addition, the word “commercial” has a context in Figure 2. The full story segment title is “commercial- new computer system”.

Assignee respectfully submits that in no place in Cobbley et al. do they teach or suggest that the story segment title “commercial-new computer system” is a television commercial. Rather, because it falls under the subject matter heading 212 of “local news”, each of the indented items (city counsel, election results, local resident accidentally shoots himself, cities, auto plan considers expansion, commercial-new computer system) are local news stories by definition. Each of these are taught as separate story segment titles.

Assignee therefore respectfully submits that there is no teaching in Cobbley et al. of a module configured to classify a media collection as program content versus television commercials. It is clear that the disclosure of Cobbley et al. in window 210 all encompass

program content. The program content falls under individual subject matter headings covering sports, local news, national news and weather. Therefore, Assignee respectfully submits that there is no teaching or suggestion of classifying the media collection in the categories defined in claim 1.

The other portion of the bolded language on page 2 of the Office Action proves Assignee's point. A repeating news transmission discussed in column 5, lines 60-67 may transmit sports news for five minutes every half hour starting at 10 minutes past the hour. Assignee notes that it is certainly unlikely that a person of skill in the art reading this reference would determine that part of the secondary data would include television commercials that would be broadcast for 5 minutes every half hour starting at 10 minutes past the half hour. Indeed, column 5 of Cobbley et al. only states the example as being sports news. Assignee respectfully submits that the temptation to utilize what is gleaned from Assignee's invention has crept too far into the analysis so as to color the interpretation of Figure 2 such that the interpretation of the "commercial-new computer system" has been expanded beyond its natural scope and beyond from what facts can be "gleaned from the prior art" into being the equivalent of television commercials. There is no such suggestion within the teachings of Cobbley et al.

Furthermore, Assignee respectfully submits that the equating in the Office Action of television commercials with the local news subject matter creeps into other parts of the analysis. For example, pages 3 and 4 of the Office Action also in bold state that "Cobbley does not clearly show that various secondary data (which includes commercials) are all commercials being presented chronologically separate from the program content." Again, Assignee strongly disputes the conclusion that the secondary data "includes commercials". As established above, such secondary data does not encompass television commercials in the teachings of Cobbley et al.

The Office Action then cites on page 4 from Hooks et al. in which they disclose the method of storing and delivering ads where ads are presented chronologically separate from the program content. Assignee in this case respectfully traverses the conclusion that a *prima facie* case of obviousness has been established. Under KSR, and under MPEP 2142, it states “the key to supporting any rejection on a 35 U.S.C. §103 is the clear articulation of the reason (S) why the claimed invention would have been obvious.” KSR requires that the analysis supporting the rejection under 35 U.S.C. §103 should be made explicit. The federal circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 550 U.S. at \_\_\_ 82 USPQ2d at 1396.

In this case, the Office Action on page 4, after mentioning that Hooks discloses advertisements, simply states “Cobbley as modified by Hooks, indexes hosted talk shows, show topics, guests [sic], etc., using various indexing techniques, such as speech recognition, closed captioning, etc....” Assignee respectfully submits that the analysis here turns away from advertisements, and the analysis here fails to establish or articulate any rational supporting a rejection under 35 U.S.C. §103. In other words, when the combination of references is articulated (“Cobbley as modified by Hooks...”), there is no mention of advertisements. Cobbley et al. already teach indexing program segments utilizing a speech recognition processor closed captioning. See column 4, lines 42-50. Therefore, nothing taught by Hooks is necessary to index “host to talk shows, show topics, guests... using various indexing techniques, such as speech recognition and closed captioning.” Assignee’s basic point is that Hooks et al. is cited as for delivering of ads but there is no articulation on page 4 with respect to why one of skill in the art would utilize advertisements in the teachings of Cobbley et al. The conclusory statement fails to even mention advertisements. Therefore,

Assignee respectfully submits that a *prima face* case of obviousness has failed to be established.

The analysis on page 7 with respect to the combination of Cobbley et al and Hooks et al. is similarly devoid of any analysis and merely encompasses a conclusory statement. For example, the Office Action after citing that Hooks s teaches storing and delivering ads and the ads are presented chronologically simply concludes “therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Hooks into the system of Cobbley to index, search and present ads in an orderly manner to provide more effective delivering of ads in accordance to preferences of user(s).” Assignee notes that this is clearly simply a conclusory statement because it begins with the word “therefore”. Assignee respectfully submits that merely because there is a reference such as Hooks et al. that focuses on the delivery of advertisements does not automatically mean that one of skill in the art would index, search and present ads according to the invention of Cobbley et al. Indeed, when the teachings of Cobbley et al. are analyzed in more detail, it becomes clear that one of skill in the art would not likely index, search and present ads in an orderly manner. In fact, and perhaps most importantly, column 4, line 51 expressly teaches that such commercial data would be discarded. Here, Cobbley et al. explain:

“broadcast receiver 110 transfer the received broadcast information to index data capture device 112. Index data capture device 112 obtains the information from the broadcast information and discards the remaining broadcast information.” (emphasis added)

Therefore, Assignee respectfully submits that there is substantial evidence within the express teachings of Cobbley et al. that commercial information that is outside of a news broadcast is expressly discarded. This is supported again by the fact that the story summary in

window 210 of Figure 2 fails to disclose anything with respect to commercials. If all of the broadcast information that is outside of a program is discarded, Assignee respectfully submits that this adds substantial weight to our argument that one of skill in the art would not likely utilize the teachings of Hooks et al. to begin to index, search and present ads in an orderly manner. According to Cobbley et al., no ads will exist at the index capture device 112 shown in Figure 1. Indeed, returning to column 11 of Cobbley et al., the interface 200 shown in Figure 2 is displayed to the individual user by client system 140 of Figure 1. See column 11, lines 5-9. As shown in Figure 1, if the index data capture device discards all broadcast information outside of the news broadcast, then the client devices 140 shown in Figure 1 will simply never even receive such discarded broadcast information. Accordingly, Assignee respectfully submits that one of skill in the art, absent impermissible hindsight, would consider it obvious to incorporate the teachings of Hooks et al. into the system of Cobbley et al. to index, search and present ads.

Assignee also respectfully notes that MPEP 2143.01, Section II requires the Examiner to weigh the power of each reference to suggestion solutions to one of ordinary skill in the art when the teachings of two or more references conflict. One must consider the degree to which one reference might accurately discredit another. In this case, it is clear that Cobbley et al. teach discarding broadcast information that is outside of the news broadcast or other television program. If such is the case, this clearly conflicts with the teachings of Hooks et al. to the extent that one of skill in the art would not likely change the principle of operation of Cobbley et al. to no longer discard such remaining broadcast information for the mere purpose of indexing, searching and presenting ads to a user. Indeed, it certainly can be argued that it would be common knowledge to one of skill in the art that the users may not be interested in organizing and viewing the advertisements in contrast to the substantive program segments. Assignee therefore respectfully submits that Assignee has presented substantial rebuttal evidence and that

the preponderance of the evidence is in Assignee's favor. Therefore, Assignee respectfully submits that claim 1 is patentable and in condition for allowance since one of skill in the art would not likely incorporate the teachings of Hooks et al. into the system of Cobbley et al.

Assignee respectfully submits that this has bearing on the fact of whether Dimitrova should be combined with Cobbley et al. as modified with Hooks et al. Since Cobbley et al. should not be modified by Hooks et al. in the manner proposed in the Office Action, Assignee respectfully submits that the claims are patentable since Dimitrova cannot be incorporated into a system that embodies the combination of Cobbley et al. and Hooks et al. Therefore, Assignee respectfully submits that claims, 1, 3, 4, 6 and 18 are patentable and in condition for allowance.

**Rejection of Claims 5 and 7 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 5 and 7 under 35 U.S.C. §103(a) as being unpatentable over Cobbley et al. in view of Hooks et al. and further in view of Dimitrova and further in view of Hoffert et al. (U.S. Patent No. 5,983,176) ("Hoffert et al."). Assignee respectfully submits that claims 5 and 7 are patentable and in condition for allowance inasmuch as the two primary references of Cobbley et al. and Hooks et al. should not be combined.

**CONCLUSION**

Having addressed all rejections and objections, Assignee respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

Date: February 23, 2010

By:  \_\_\_\_\_

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